

Remarks/Arguments

The Objection of Claims 9, 10, and 16-18 as Being Dependent Upon a Rejected Base Claim

Claims 9, 10, and 16-18 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have shown that Claim 1 is novel with respect to and patentable over the cited references. Claims 9, 10, and 16-18, dependent from Claim 1, enjoy the same distinction from the cited references. Applicants courteously request that the objections be removed.

Rejection of Claims 1, 2, 14, 15, 19, 20, and 22-24 under U.S.C. §103(a)

The Examiner rejected Claims 1, 2, 14, 15, 19, 20, and 22-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,705,416 (Glonner) in view of U.S. Patent No. 6,808,470 (Boll). Applicants respectfully traverse the rejection.

Applicants' can overcome a 102(e) prior art reference by proving they are entitled to a 35 USC §119 priority date, such as a foreign application, which is earlier than the reference's US filing date. See *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Applicants have included in this response a translation of priority document DE 102 38 866 in order to perfect a priority claim to the August 24, 2002 filing date of that application, pursuant to 37 CFR 1.55. Applicants verify that the translation of a certified copy of DE 102 38 866 that is attached is accurate. Applicants also assert that DE 102 38 866 fully supports and enables Claims 1, 2, 14, 15, 19, 20 and 22-24 of the present application pursuant to 35 USC 112.

Foreign applications' filing dates that are claimed under 35 USC 119(a)-(d), (f) of 365(a) in applications, which have been published as US or WIPO application publications or patented in the US may not be used as 35 USC 102(e) dates for prior art purposes. See MPEP 2136.03 & MPEP 201.15. Since Boll is a United States Patent claiming priority to a German application the earliest date that the Boll reference qualifies as prior art under 35 USC 102(e) is November 27, 2002, which is the United States filing date. See MPEP 2136.03. Applicants' priority date,

August 24, 2002, antedates the priority date of the Boll reference, November 27, 2002. Thus, Boll does not qualify as prior art against the present application.

The Examiner has indicated that Boll can be combined with Glonner to render Claim 1 of the present application obvious since Boll discloses the missing element of gearbox clutch slipping. The Examiner has indicated that Glonner fails to disclose the gearbox clutch slipping taught in Claim 1. Specifically, "the step of operating the starter generator between the two clutches to turn on the drive unit at a moment in time when the gearbox clutch changes into a slipping state." The Examiner submitted that Boll cures the defects of Glonner, but since Boll can no longer qualify as a prior art reference the argument is now invalid.

Since Boll no longer qualifies as a prior art reference, the Examiner has failed to prove a *prima facie* case of obviousness for Claim 1. This is due to the fact that Boll cannot be used as a prior art reference, and thus it cannot be used in combination with Glonner to reject Claim 1. The Examiner has indicated that Glonner alone does not teach, suggest, or motivate the elements of Claim 1. Therefore, Claim 1 is patentable. Claims 2, 14, 15, 19 and 20, which are dependent from Claim 1, enjoy the same distinction from the cited references. Applicants courteously request that the rejections be removed.

Claim 22:

Claim 22 recites substantially the above-mentioned elements of Claim 1. Applicants have shown that Claim 1 is patentable over Glonner and Boll. Therefore, Claim 22 also is patentable over Glonner and Boll. Claims 23 and 24, which are dependent from Claim 22, enjoy the same distinction from the cited references. Applicants courteously request that the rejections be removed.

Rejection of Claims 3, 4 and 7 Under U.S.C. §103(a)

The Examiner rejected Claims 3, 4 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,705,416 (Glonner) in view of U.S. Patent No. 6,808,470 (Boll) as applied to Claims 1 and 22 above, and further in view of U.S. Patent No. 6,491,602 (Hoehn). Applicants respectfully traverse the rejection.

As discussed above Boll does not qualify as prior art. Thus, the combination of Glonner, Boll and Hoehn can't be used to reject Claims 3, 4 and 7. Applicants courteously request that the rejections be removed.

Hoehn does not cure the defects of Glonner

Hoehn fails to provide any teaching or suggestion that the gearbox clutch in Claim 1 is in a slipping state, and Boll no longer qualifies as prior art, so Claim 1 is patentable over Glonner, Boll, and Hoehn. Claims 3, 4, and 7, dependent from Claim 1, enjoy the same distinction from the cited references. Applicants courteously request that the rejections be removed.

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



C. Richard Lohrman
Registration No. 46,878
Attorney for Applicants
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

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Appendix

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TRANSLATIONS

City of New York, State of New York, County of New York

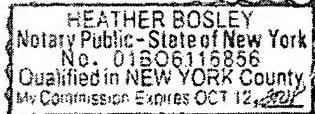
I, Jinmin Lee, hereby certify that the following is, to the best of my knowledge and belief, a true and accurate translation of the Patent Application serial number DE 102 38 866.0 filed on August 24, 2002 from German into English.

Jinmin Lee

Sworn to before me this

22nd day of February, 2006

Signature, Notary Public



Stamp, Notary Public
State of New York

THREE PARK AVENUE, 39TH FLOOR, NEW YORK, NY 10016 T 212.689.5555 F 212.689.1059 WWW.TRANSPERFECT.COM

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